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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

ART UNIT

PAPER NUMBER

DATE MAILED: 11/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Notification of Non-Compliant Appeal Brief (37 CFR 41.37)</b>	<b>Application No.</b> 09/996,244	<b>Applicant(s)</b> SCHAEFER ET AL.	
	<b>Examiner</b> Rick Palabrica	<b>Art Unit</b> 3663	

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address--**

The Appeal Brief filed on 18 March 2005 is defective for failure to comply with one or more provisions of 37 CFR 41.37.

To avoid dismissal of the appeal, applicant must file an amended brief or other appropriate correction (see MPEP 1205.03) within **ONE MONTH or THIRTY DAYS** from the mailing date of this Notification, whichever is longer.

**EXTENSIONS OF THIS TIME PERIOD MAY BE GRANTED UNDER 37 CFR 1.136.**

1. ☐ The brief does not contain the items required under 37 CFR 41.37(c), or the items are not under the proper heading or in the proper order.
2. ☐ The brief does not contain a statement of the status of all claims, (e.g., rejected, allowed, withdrawn, objected to, canceled), or does not identify the appealed claims (37 CFR 41.37(c)(1)(iii)).
3. ☐ At least one amendment has been filed subsequent to the final rejection, and the brief does not contain a statement of the status of each such amendment (37 CFR 41.37(c)(1)(iv)).
4. ☒ (a) The brief does not contain a concise explanation of the subject matter defined in each of the independent claims involved in the appeal, referring to the specification by page and line number and to the drawings, if any, by reference characters; and/or (b) the brief fails to: (1) identify, for each independent claim involved in the appeal and for each dependent claim argued separately, every means plus function and step plus function under 35 U.S.C. 112, sixth paragraph, and/or (2) set forth the structure, material, or acts described in the specification as corresponding to each claimed function with reference to the specification by page and line number, and to the drawings, if any, by reference characters (37 CFR 41.37(c)(1)(v)).
5. ☐ The brief does not contain a concise statement of each ground of rejection presented for review (37 CFR 41.37(c)(1)(vi)).
6. ☐ The brief does not present an argument under a separate heading for each ground of rejection on appeal (37 CFR 41.37(c)(1)(vii)).
7. ☐ The brief does not contain a correct copy of the appealed claims as an appendix thereto (37 CFR 41.37(c)(1)(viii)).
8. ☐ The brief does not contain copies of the evidence submitted under 37 CFR 1.130, 1.131, or 1.132 or of any other evidence entered by the examiner **and relied upon by appellant in the appeal**, along with a statement setting forth where in the record that evidence was entered by the examiner, as an appendix thereto (37 CFR 41.37(c)(1)(ix)).
9. ☐ The brief does not contain copies of the decisions rendered by a court or the Board in the proceeding identified in the Related Appeals and Interferences section of the brief as an appendix thereto (37 CFR 41.37(c)(1)(x)).
10. ☒ Other (including any explanation in support of the above items):

See Continuation Sheet.

Continuation of 10. Other (including any explanation in support of the above items):

1. As to item 4, the Summary of the Invention is inaccurate, as evidenced by the following examples:

a) At section (5) (A), appellant states, "The invention is based upon the discovery that free thermal neutrons can be trapped within the cage-like structure of a fullerene molecule (page 3, lines 9-13)." See page 2, of the Supplemental Brief. Firstly, the cited part of the specification does not use the term, "discovery." Secondly, the term, "discovery" means "an act of finding or observing something." Based on appellant's specification, he did not find or observe that neutrons can be trapped inside a fullerene molecule but rather ONLY INFERRED such trapping based on an alleged presence of a pure beta emitter, as evidenced by the following statement:


"Evidence that neutrons are trapped in the fullerene molecules consists of the presence of a pure beta emitter in the fullerene that remains after the counts resulting from the gamma emitters have been stripped from the raw data. The pure beta emitter has a half life anywhere near ten minutes. There are very few pure beta particle emitters with a half life anywhere near ten minutes. The rarity of these pure beta emitters, their chemical nature, and the chemical nature of the fullerene all point to the conclusion that they cannot be the source of the pure beta emitter observed in the irradiated fullerene. The only other possible source of the radiation is the decay of free neutrons." see page 7, lines 18+ of the specification.

b) At section (5) (B), appellant inaccurately uses the above citation to provide reference to his claim 19, by changing the last sentence to read:

"The only source of this beta emission known to the applications (sic) is the free thermal neutron (page 9, lines 28-30)." See page 3 of the Supplemental Brief.

This statement is contrary to, and a misrepresentation of, the specification which indicates that the thermal neutron is the other POSSIBLE source and NOT the ONLY other source of the beta emitter. The specification clearly states that the thermal neutron is only a CANDIDATE source and not the DEFINITIVE source of the beta emitter.

2. The arguments on pages 9-12 of the Supplemental Brief regarding the 112, second paragraph rejection of the claims, still do not correct the previously cited deficiencies in the 1/04/05 Office action and repeated in the 2/16/05 Office action. Merely pointing out what a claim recites (or is directed to) or pointing out what a claim is not directed to (which is equivalent to further highlighting what the claim recites or is directed to) is not considered an argument for separate patentability of the claim. See 37 CFR 41.37(c).

  
RICARDO J. PALABRICA  
PRIMARY EXAMINER